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TS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/024, 923 02/17/98 KIKINIS

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CENTRAL COAST PATENT AGENCY
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AROMAS CA 95004

TM01/0605

EXAMINER

KWOH, J

ART UNIT

PAPER NUMBER

2663

12

DATE MAILED:

06/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks*SA*

Office Action Summary	Application No.	Applicant(s)
	Examiner Jasper Kwoh	Art Unit 2663
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
Period for Reply		
<p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p>		
<ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
Status		
<p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Mar 21, 2001</u></p>		
<p>2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final.</p>		
<p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p>		
Disposition of Claims		
<p>4) <input checked="" type="checkbox"/> Claim(s) <u>1-17</u> is/are pending in the application.</p>		
<p>4a) Of the above, claim(s) _____ is/are withdrawn from consideration.</p>		
<p>5) <input type="checkbox"/> Claim(s) _____ is/are allowed.</p>		
<p>6) <input checked="" type="checkbox"/> Claim(s) <u>1-17</u> is/are rejected.</p>		
<p>7) <input type="checkbox"/> Claim(s) _____ is/are objected to.</p>		
<p>8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.</p>		
Application Papers		
<p>9) <input type="checkbox"/> The specification is objected to by the Examiner.</p>		
<p>10) <input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.</p>		
<p>11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved.</p>		
<p>12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>		
Priority under 35 U.S.C. § 119		
<p>13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).</p>		
<p>a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:</p>		
<p>1. <input type="checkbox"/> Certified copies of the priority documents have been received.</p>		
<p>2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p>		
<p>3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p>		
<p>*See the attached detailed Office action for a list of the certified copies not received.</p>		
<p>14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).</p>		
Attachment(s)		
<p>15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s): _____</p>		
<p>16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p>		
<p>17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) <input type="checkbox"/> Other: _____</p>		

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,201,804 B1 in view of Iwami et al.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the application's claims merely broaden the scope of the patented claims by not claiming some elements (i.e. DNT call center, CTI servers) and combining with the live conversation between two different networks as taught by Iwami et al. The application's claims are nearly identical in every other respect to the patent claims. Therefore, the application's claims are simply broader versions of the patented claims and the live conversation between two

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different network is an obvious modification. It is the examiner's position that broadening the patented claims by not claiming some of the claimed elements (i.e. DNT call center, CTI servers) and including obvious combination of the patented claims such as live conversation where one person is on a data network and another on the COST network would have been obvious to one of the ordinary skill in the art in view of the patented claims.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-2, 5-8 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. in view of Iwami et al.

Regarding claims 1 and 13, Williams et al. discloses bridge unit comprising: a trunk-line port for receiving and placing COST calls (i.e. 14, 15); a data network port for receiving and placing DNT calls; conversion circuitry (i.e. 15); control routines wherein a first call is dynamically converted and placed on the other network (i.e. col. 5, ll. 15-25). Williams does not specifically disclose dynamically allowing two people to engage in a live conversation where one is on a data network and the other is on a COST network. However Iwami et al. teaches a live conversation where one person is on a COST network (i.e. 3) and other on a data network (i.e. 1). It would have been obvious to an ordinary person skilled in the art at the time of the

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invention to include dynamically allowing two people to engage in a live conversation where one is on a data network and the other is on a COST network as taught by Iwami et al. with the bridge unit of Williams et al. in order to increase the flexibility of the system by allowing at least one of the caller to use the multimedia computer to communicate instead of a telephone.

Regarding claim 7, Williams et al. discloses a method for converting calls comprising: connecting a COST trunk line to a trunk-line port (i.e. 14, 15); connecting a data network line to a data network port (i.e. 15, 16); receiving a first call (i.e. fig. 1A); placing a second call (i.e. 1B); and dynamically convert data (i.e. col. 5, ll. 15-25). Williams does not specifically disclose dynamically allowing two people to engage in a live conversation where one is on a data network and the other is on a COST network. However Iwami et al. teaches a live conversation where one person is on a COST network (i.e. 3) and other on a data network (i.e. 1). It would have been obvious to an ordinary person skilled in the art at the time of the invention to include dynamically allowing two people to engage in a live conversation where one is on a data network and the other is on a COST network as taught by Iwami et al. with the bridge unit of Williams et al. in order to increase the flexibility of the system by allowing at least one of the caller to use the multimedia computer to communicate instead of a telephone.

Regarding claims 2, 8 and 14-15, Williams et al. disclose the first network being a PSTN (i.e. 11-14) and the second the internet (i.e. 10).

Regarding claims 5-6 and 11-12, Williams et al. do not specifically disclose negotiating with the caller to ascertain the number using an interactive voice response unit (IVR). However,

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Iwami et al. teach the use of IVR (i.e. fig. 5) in a voice communication system to obtain the desired address or phone number (i.e. abstract). It would have been obvious to an ordinary person skilled in the art at the time of the invention to include an IVR to audibly receive the desired information as taught by Iwami et al. with the system and method of Williams et al. in order to provide customers with greater ease and friendlier atmosphere when placing a call.

5. Claims 3-4 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. in view of Iwami et al further in view of Ito et al.

Williams et al. does not specifically discloses retrieving IP address using a telephone number and accessing a look-up table to place a call. However, Ito et al. discloses address using a telephone number and accessing a look-up table to place a call (i.e. 4). It would have been obvious to an ordinary person killed in the art at the time of the invention to include a converting table as taught by Ito et al. with the method and apparatus of Williams et al. in order to route calls from IP environment to PSTN and vis versa.

6. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al.

Williams do not specifically disclose a bridge between two COST or DNT. However, Williams teaches that two different networks with two different protocols needs to be connected by a bridge as described above. Therefore it would have been obvious to modify by including converting protocols of two COST and two DNT with the bridge as described above in order to have the user to communicate through different systems.

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Response to Arguments

7. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasper Kwoh whose telephone number is (703) 305-0101.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen, can be reached on (703) 308-5340.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 305-3988 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

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Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal
Drive, Arlington, VA., Sixth Floor (Receptionist).

Jasper Kwoh



June 3, 2001



CHAU NGUYEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800